



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,008	10/12/2001	Christian Terfloth	#EL489599575US	2033

7590 06/08/2005

Vincent M Fazzari
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue Suite 1210
New York, NY 10176

EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,008

Applicant(s)

TERFLOTH ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-57 and 69-77 is/are allowed.
- 6) ☒ Claim(s) 58-62, 64-68, 78, 80 and 81 is/are rejected.
- 7) ☒ Claim(s) 63 and 79 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 0205
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon PCT/DE00/00384 filed on February 10, 2000. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Double Patenting

2. Claim 81 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 66. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 66 limits the subject matter of claim 58 to include the content of the isocyanate-reactive polymer to the range set forth in claim 81. Since claim 81 and claim 58 are identical except for this range difference, claims 66 and 81 are substantial duplicates.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1712

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 58-62, 64-68, 78, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossitto (U.S. Patent No. 5,977,283) in view of Helmeke et al. (U.S. Patent No. 5,869,593) and Yang et al. (U.S. Patent No. 6,207,248).

For claims 58 and 60, in column 2, lines 25-45, Rossitto teaches adhesives with superior characteristics. In column 2, line 65 through column 3, line 26, Rossitto discloses a hot melt adhesive that contains an isocyanate-reactive polymer and a polyfunctional isocyanate. In column 4, line 52 through column 5, line 11, Rossitto teaches that the molecular weight of the isocyanate-reactive polymer is preferably

Art Unit: 1712

between 8,000 and 15,000 Da. For claim 65, in column 5, lines 33-48, Rossitto teaches that the isocyanate-reactive polymer is a polyester containing hydroxyl groups. For claims 58, 60, 66, 68, and 81, in column 7, lines 35-39, Rossitto teaches the presence of 80-90 parts by weight of the isocyanate-reactive component and 10 to 20 parts of the isocyanate, which corresponds to an amount of isocyanate-reactive polymer of 80-90% by weight. This is within applicant's range, where the ratio of (a) to (b) is from 4:1 to 9:1. Here, for claim 58, Rossitto teaches that the blending takes place while heating. Under this melt blending process, the components are blended to a liquid state.

For claims 58, 60, and 81, in column 8, lines 14-28, Rossitto teaches that the components may be present in granular form.

For claim 64, in column 6, lines 19-62, Rossitto teaches that the isocyanate is preferably present in solid form at room temperature and may be TDI.

For claim 67, Rossitto does not teach that a resin is present; corresponding to applicant's an amount of 0% by weight.

For claim 59, in column 9, lines 12-26, Rossitto teaches that the adhesive package is stored for up to 6 months, which would allow for transportation to the automotive upholstering plant.

For claim 60, in column 8, lines 55-64, Rossitto teaches that the composition is converted into a film by conventional casting or film extrusion techniques, which involve the use of die applications.

For claims 58, 60, 62, and 78, Rossitto fails to teach the presence of polymer that is not isocyanate reactive and is selected from the group consisting of ethylene/vinyl-acetate copolymer and/or polyolefin.

In column 3, lines 10-16, Helmeke teaches that thermoplastic components are added to polyurethane hot melt adhesives to improve film forming characteristics. In column 6, line 33 through column 7, line 4, Helmeke teaches that ethylene/vinyl-acetate copolymers available under the tradename of Elvax® are added in an amount of preferably 5 to 20% by weight of the composition. Yang teaches in column 13, lines 30-33, that particular ethylene/vinyl-acetate copolymers available under the tradename of Elvax® suitable for hot melt adhesives have a vinyl-acetate content of 33% and a melt index of from 400.

Rossitto and Helmeke are analogous art in that they both teach hot melt adhesives that contain polyurethane forming ingredients. Yang is analogous art because it teaches polyurethane hot melt adhesives containing Elvax® ethylene/vinyl-acetate copolymers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the ethylene/vinyl-acetate copolymers of Helmeke with the particular Elvax® copolymers set forth in Yang in the hot-melt adhesives of Rossitto. The motivation would have been that Helmeke teaches that the addition of these copolymers improves film-forming properties. The motivation to add the particular copolymers taught by Colon would have been that Helmeke teaches a broad genus of copolymers that may be added, namely those ethylene/vinyl-acetate copolymers with the tradename

Elvax®. One of ordinary skill in the art would have turned to Yang for specific copolymers within the genus that are particularly suitable for hot-melt adhesives.

Response to Arguments

7. Applicant's arguments filed 3/09/2005 have been fully considered but they are not persuasive.

The examiner incorporates by reference all of the previously made arguments in response to applicant's incorporation by reference of all the previously submitted comments or arguments regarding the Rossitto, Helmeke, and Yang references.

As indicated in the interview of February 28, 2005, the examiner has consulted with a special programs examiner, Christine Tierney, regarding applicant's claim for foreign priority. As a point of emphasis, ***the following comments apply to applicant's claim for FOREIGN priority under 35 U.S.C. §119 ONLY.***

The claim for foreign priority is not proper. The examiner pertinent section of the statute for this claim is 35 U.S.C. § 365. This section states that a priority claim may be granted to an international application designating at least one other country besides the U.S. However, the claim must still conform to the requirements of 35 U.S.C. §119(a)-(d). The requirement of 35 U.S.C. §119(a) requires that the U.S. application be filed within twelve months of the filing of the foreign application. This is not the case here since the international application was filed on February 10, 2000, which is 20 months prior to the filing of the U.S. application. Thus, applicant is not entitled to a claim of *foreign* priority to the international application.

To overcome this problem, applicant should file an application data sheet that sets forth a foreign priority claim section, where reference to the international application is removed.

Regarding applicant's arguments with respect to claims 58, 60, 80, and 81, applicant first argues that Rossitto and Helmke disclose one component systems and that the blends of Rossitto are at least partially reacted. Applicant argues that the present claims are distinguishable from this because they are directed to multicomponent systems, and therefore Rossitto and Helmke actually teach away from the present claims. Applicant argues that the examiner's argument is not correct because the whole specification text and also the claims clearly reflect that the two reactive species are present in separate components and the mixing of the two components takes place only immediately during its application. The examiner disagrees. The claims do not clearly reflect that the two reactive species are present in separate components. None of claims 58, 60, 80, and 81 recites that there are "separate components." The claims state that first and second components are blended. The examiner's position is that this does not distinguish the teachings of Rossitto. The term "component" is interpreted by the examiner to mean an ingredient of the composition, and the method as claimed recites a mixing or blending of these ingredients. The fact that there is more than one component makes the system a multicomponent system.

Applicant also argues that Rossitto has nothing in common with the present invention and teaches away from the present claims. The examiner disagrees. Claims

Art Unit: 1712

58, 60, 80, and 81 do not claim that the components are stored separately and the Helmeke reference suggests the addition of ethylene/vinylacetate copolymers and/or polyolefins to improve film-forming properties. In addition, Rossitto does not teach away from the present claims because the present claims teach a mixture of components as set forth by Rossitto above.

Applicant additionally argues that the teachings of Helmeke and Yang cannot be used to remedy the deficiency of Rossitto regarding the addition of ethylene/vinylacetate copolymers and/or polyolefins because these references teach one-component systems. However, as set forth above, there is no indication in the rejected claims that the components existed as stored separate components as argued by applicant. In addition, Rossitto and Helmeke (and Yang) are directed to hot-melt polyurethane adhesives and are therefore analogous art with respect to each other.

Last, applicant cites *In re Pleuddemann*, *In re Kuehl*, and *Ex parte Glaister* arguing that this case law renders the rejected method claims allowable since the composition claims were not rejected. The examiner disagrees. Each of the cited cases applies to situations where the compositions were allowed and the method claims were rejected based on analogous art, in effect using the composition claims as prior art. This is not the case here. The combination of references applied above by the examiner teaches the same method as claimed by applicant, not an analogous process. The chemical identities of the components used are the same as claimed by applicant. Furthermore, the instant composition claims are allowable not based on the identity of

Art Unit: 1712

the components, but based on the form of the composition. Therefore, these cases are distinguished based on their facts.

In addition, the compositions as claimed are not the same compositions as set forth in the method claims. The composition claims set forth components present "as separate components". The method claims make no such recitation. For these reasons the rejection set forth above is continued.

Allowable Subject Matter

8. Claims 47-57 and 69-77 are allowed.
9. Claims 63 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

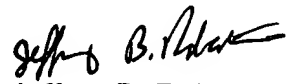
Art Unit: 1712

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR